UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,423	09/15/1999	KAORU UCHIDA	072982-0191	7427

7590   02/09/2004

FOLEY & LARDNER
SUITE 500
3000 K STREET N W
WASHINGTON, DC 200075109

EXAMINER
MAHMOUDI, HASSAN

ART UNIT	PAPER NUMBER
2175	

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,9,10 and 15-18* is/are rejected.

7)☒ Claim(s) *5-8 and 11-14* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

       1.☒ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

DOV POPOVICI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. In response to communications filed on 19-November-2003, claims 3 and 15 are amended, and new claims 16-18 are added per applicant's request. Therefore, claims 1-18 are presently pending in the application.

Claim Objections

2. Claims 5-8 and 11-14, and 16-18 are objected to because of the following informalities:

In claims 5 and 6, line 8, "a instruction" should be changed to --an instruction--. Correction is required.

In claim 16, line 4, "with regards completion" should be changed to --with regards to completion--. Correction is required.

Claims 7, 11, and 13 are objected to because they are dependents from the objected to dependent claim 5.

Claims 8, 12, and 14 are objected to because they are dependents from the objected to dependent claim 6.

Claims 17-18 are objected to because they are dependents from the objected to dependent claim 16.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17 and 18, in line 1, recite "a storage medium as claimed in claim 16". There is insufficient antecedent basis for these limitations in the claim, because claim 16 is "an information processing method" claim. For the purpose of examination, the examiner is making the assumption that claims 17 and 18 should recite "an information processing method as claimed in claim 16". Appropriate corrections are required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of

2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-4, 9-10, and 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Black

(U.S. Patent No. 6,5,39,101.)

As to claim 1, Black teaches an information processing method using fingerprint

identification (see Abstract) comprising the steps of:

identifying user according to an inputted fingerprint (see column 1, lines 30-35, and see

column 9, lines 8-22);

preserving user's individual information associated with the user regarding a device in

every identified user at the time when the user suspends use of the device which the user uses

(see column 5, lines 19-64); and

selecting the user's individual information corresponding to identified user, which is

preserved, to provide for the user when the user resumes use of the device (see column 23,

lines 15-22.)

As to claims 2 and 4, Black teaches wherein the user's individual information (see

column 5, lines 19-64) includes any of work progressive information, work environmental

information, and work historical information of the user who uses the device (see column 5,

lines 19-31.)

As to claim 3, Black teaches an information processing device using fingerprint

identification (see Abstract) comprising:

a fingerprint image input means for acquiring fingerprint image of a user (see figures 1B,

2A, 2B, 3A,and 3B) to output the fingerprint image to a fingerprint feature extraction means

(see column 9, line 8 through column 10 line 31);

a suspension / resumption management means accepting instruction corresponding to

either suspension or resumption of use of the device from the user to output the instruction

for either suspension or resumption to a fingerprint feature extraction means and a user

individual information storage means (see column 12, lines 12-31, where

"suspension/resumption" is read on "grant or deny access");

the fingerprint feature extraction means (see column 9, lines 66 through column 10, line

2) receiving the fingerprint image from the fingerprint image input means (see figures 3A

and 3B), before extracting fingerprint feature from the fingerprint image, when received

instruction from the suspension / resumption management means is suspension, outputting

the fingerprint feature to the user individual information storage means (see column 15, lines

3-10), while when received instruction from salt suspension / resumption management means

is resumption (see column 12, lines 12-31, where "suspension/resumption" is read on "grant

or deny access"), outputting the fingerprint feature to a fingerprint matching means (see

column 10, lines 61-67);

a user individual information storage means (see column 15, lines 3-10) storing therein

the fingerprint feature received from the fingerprint feature extraction mean associated with

the user's individual information regarding the device when instruction received from the

suspension / resumption management means is suspension (see column 9, lines 23-35), while

when instruction received from the suspension / resumption management means is

resumption outputting the stored fingerprint feature, as well as all other stored fingerprint

features as a registered fingerprint feature group (see column 7, lines 51-67; column 9, lines

30-35; and see column 19, lines 49-58), to receive matching result from fingerprint matching

means (see column 10, lines 61-67), subsequently, selecting fingerprint feature from among

the fingerprint features in the registered fingerprint feature group according to the matching

result (see column 10, lines 65-67, and see column 19, lines 1-8, where "feature group" is

read on "set of prints"), thus selecting the user's individual information associated with the

selected the fingerprint feature in order to output to user individual information processing

means (see column 23, lines 15-22);

the fingerprint matching means (see column 10, lines 61-67) receiving the registered

fingerprint feature group from the user individual information storage means before

implementing matching processing between the registered fingerprint feature group and the

fingerprint feature received from the fingerprint feature extraction means, thus outputting

matching result to the user individual information storage means (see column 19, lines 49-

58); and

the user individual information processing means receiving the user's individual

information from the user individual information storage means, before implementing

specific processing in answer to content of the user' individual information (see column 15,

lines 35-57.)

As to claims 9-10, <u>Black</u> teaches wherein the information processing device using

fingerprint identification (see column 15, lines 35-57) is any of an electronic picture book

device, a game device, and a retrieval device (see figure 17B, and see column 5, lines 8-18.)

As to claim 15, <u>Black</u> teaches a storage medium (see column 28, lines 57-61) stored

therein a computer implemented information processing program using fingerprint

identification (see Abstract) comprising the steps of:

a step for identifying user according to an inputted fingerprint (see column 1, lines 30-35,

and see column 9, lines 19-22);

a step for accepting an instruction of either suspension or resumption (see column 12,

lines 12-31, where "suspension/resumption" is read on "grant or deny access");

a step for storing the user's individual information regarding usage of a device into which

the program is installed associated with the user in the case of reception of instruction of

suspension in every identified user (see column 15, lines 3-10); and

a step for selecting the individual information corresponding to an identified user in the

case of reception of instruction of resumption obtained from user's individual information

stored previously (see column 23, lines 15-22.)

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that said subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (U.S.

Patent No. 6,5,39,101) in view of Ahn (U.S. patent No. 5,978,924.)

As to claim 16, Black teaches individual information (see column 5, lines 53-60, and see

column8, lines 36-40.)

Black does not teach wherein the user's individual information includes work progressive

information that provides information on how much the user accomplished with regards to

completion of an operation that is performed by utilizing the device when the device was

suspended.

Ahn teaches a computer system (see Abstract), in which he teaches wherein the user's

individual information includes work progressive information that provides information on

how much the user accomplished with regards to completion of an operation that is

performed by utilizing the device when the device was suspended (see column 5, line 22

through column 6, line 8.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the

time the invention was made to have modified Black to include wherein the user's individual

information includes work progressive information that provides information on how much

the user accomplished with regards to completion of an operation that is performed by

utilizing the device when the device was suspended.

It would have been obvious to a person having ordinary skill in the art at the time the

invention was made to have modified <u>Black</u> by the teaching of <u>Ahn</u>, because including

wherein the user's individual information includes work progressive information that

provides information on how much the user accomplished with regards to completion of an

operation that is performed by utilizing the device when the device was suspended, would

enable the system to continue operation from when it was left off without repeating the steps

already successfully performed before the operation was suspended.

As to claim 17, <u>Black</u> as modified teaches wherein the step for selecting the individual

information corresponding to an identified user is performed based on matching the inputted

fingerprint (see "biometric matching" in <u>Black</u>, Abstract) with a plurality of stored

fingerprints that are stored in correspondence with a plurality of user's individual information

as a result of multiple operations of the storing step (see <u>Black</u>, column 4, lines 50-58, and

see column 22, lines 8-23, where "multiple operations" is read on using "multiple biometric

prints".)

As to claim 18, <u>Black</u> as modified teaches further comprising a step for resuming

operation of the device at an exact place within an application of the device that was

previously being run by the user when the instruction of suspension was initiated (see <u>Ahn</u>,

column 3, lines 23-41.)

Allowable Subject Matter

9. Claims 5-8 and 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record, Black (U.S. Patent No. 6,539,101) and Ahn (U.S. patent No. 5,978,924) do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim):

wherein the suspension / resumption management means outputs the instruction of either suspension or resumption to also an indication information management means in addition to the fingerprint feature extraction means and the user individual information storage means, and the user individual information processing means is provided with:

an instruction input means accepting an instruction of operation of the device from the user in order to output instruction of the operation to the indication information processing means;

a presentation information management means storing therein management information of information to be presented for the user, in order to output the management information while updating the management information in answer to instruction of the operation to presentation means when receiving instruction of the operation from the instruction input means

a presentation means receiving the management information from the presentation

information management means, before acquiring information to be presented. for the user

from the device data storage means according to the management information in order to

present; and

a device data storage means storing therein information which the device should

maintain,

when the presentation information management means receives instruction of suspension

from the suspension / resumption management means, outputting the management

information to the user individual information storage means, while when the presentation

information management means receives instruction of resumption from the suspension /

resumption management means, updating storage content according to the management

information received from the user individual information storage means, as claimed in claim

5.

Claims 7, 11, and 13 are objected to as being dependent from the objected to dependent

claim 5.

The prior art of record, Black (U.S. Patent No. 6,539,101) and Ahn (U.S. patent No.

5,978,924) do not disclose, teach, or suggest the claimed limitations of (in combination with

all other features in the claim):

wherein the suspension / resumption management means outputs the instruction of either

suspension or resumption to also an indication information management means in addition to

the fingerprint feature extraction means and the user individual information storage means,

and the user individual information processing means is provided with:

an instruction input means accepting an instruction of operation of the device from the

user in order to output instruction of the operation to the indication information processing

means;

a presentation information management means storing therein management information

of information to be presented for the user, in order to output the management information

while updating the management information in answer to instruction of the operation to

presentation means when receiving instruction of the operation from the instruction input

means

a presentation means receiving the management information from the presentation

information management means, before acquiring information to be presented. for the user

from the device data storage means according to the management information in order to

present; and

a device data storage means storing therein information which the device should

maintain,

when the presentation information management means receives instruction of suspension

from the suspension / resumption management means, outputting the management

information to the user individual information storage means, while when the presentation

information management means receives instruction of resumption from the suspension /

resumption management means, updating storage content according to the management

information received from the user individual information storage means, as claimed in claim

6.

Claims 8, 12, and 14 are objected to as being dependent from the objected to dependent

claim 6.

Response to Arguments

11. Applicant's arguments filed on 19-November-2003 with respect to the rejected claims in

view of the cited references have been fully considered but they are not found persuasive:

In response to the applicant's argument regarding the provisional dates listed on the front

page of Black reference, the argument has been fully considered but it is not found

persuasive, because according the MPEP, "the 25 U.S.C. 102(e) critical reference date of a

U.S. patent or U.S. application publication and certain international application publications

entitled to the benefit of the filing date of a provisional application under 35 U.S.C 119(e) is

the filing date of the provisional application." (See MPEP *§ 2136.03*, section III, *priority*

from provisional application under 35 U.S.C. 119(e). The cited reference, Black (U.S.

Patent No. 6,539,101), shows a clear chain of priorities back to April 7, 1988. Since the

content of a printed patent cannot be questioned, the assumption is made that the priority

claimed by the Black reference is valid.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office

action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until

after the end of the THREE-MONTH shortened statutory period, then the shortened statutory

period will expire on the date the advisory action is mailed, and any extension fee pursuant to

37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of

this final action.

13. Any inquiries concerning this communication or earlier communications from the examiner

should be directed to Tony Mahmoudi whose telephone number is (703) 305-4887. The

examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dov Popovici, can be reached at (703) 305-3830.

tm

February 2, 2004

DOV POPOVICI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100